

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent of: Artavanis-Tsakonas <i>et al.</i>	Confirmation No.: 8386
Patent No. 7,727,732 B2	Art Unit: 1647
Issued: June 1, 2010	Examiner: Stoica, Elly Gerald
Application No. 10/781,059	Filed: February 17, 2004
For: METHODS FOR IDENTIFYING MODULATORS OF NOTCH ACTIVATION	Attorney Docket No: 7326-132

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

MAIL STOP PATENT EXT.
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

United States Patent No. 7,727,732 B2 (“the ‘732 patent”) issued on June 1, 2010, and indicates a patent term adjustment under 35 U.S.C. § 154(b) of 1069 days. The ‘732 patent issued from Application No. 10/781,059 filed on February 17, 2004 (“the ‘059 application”). Attached hereto as Exhibit A is the Patent and Trademark Office’s Patent Application Information Retrieval page for U.S. Patent No. 7,727,732 B2 at Patent Term Adjustment History (“PTO PAIR Adjustment”), and attached hereto as Exhibit B is the Decision on Application for Patent Term Adjustment mailed by the Office of Petitions on April 26, 2010 (“Decision”), in connection with the ‘059 application.

Patentees hereby respectfully request reconsideration of the patent term adjustment indicated on the ‘732 patent. Specifically, Patentees believe that the patent term adjustment of 1069 days should be increased by 258 days to a total of 1,327 days. 1,327 days is equal to the number of days of Patent and Trademark Office (“PTO”) delay under 37 C.F.R. § 1.703(a) plus the number of days of PTO delay between the date three years after the filing date to the day that a patent issued on the above-identified application under 37 C.F.R. § 1.703(b), excluding any overlap in days between the periods defined under 37 C.F.R. §§ 1.703(a) and 1.703(b), less the number of days of Patentee delay under 37 C.F.R. § 1.704.

A request for reconsideration of patent term adjustment under 37 C.F.R. § 1.705(d) must be accompanied by the requirements set forth in paragraphs (b)(1) and (b)(2) of 37 C.F.R. § 1.705:

- (1) the fee set forth in 37 C.F.R. § 1.18(e); and
- (2) a statement of the facts involved, specifying:
 - (i) the correct patent term adjustment and the basis or bases under 37 C.F.R. § 1.702 for the adjustment;
 - (ii) the relevant dates as specified in 37 C.F.R. §§ 1.703(a) through (e) for which an adjustment is sought and the adjustment as specified in 37 C.F.R. § 1.703(f) to which the patent is entitled;
 - (iii) whether the patent is subject to a terminal disclaimer and any expiration date specified in the terminal disclaimer; and
 - (iv)(A) any circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in 37 C.F.R. § 1.704; or
(B) that there were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in 37 C.F.R. § 1.704.

See 37 C.F.R. § 1.705(d).

In support of this request, Patentees submit the following statement of facts:

1. Fee Required Under 37 C.F.R. § 1.705(b)(1)

Pursuant to 37 C.F.R. §§ 1.705(b)(1) and § 1.18(e), the fee required for filing this application is believed to be **\$200.00**.

Please charge the required fee to Jones Day Deposit Account No. 50-3013.

2. Statement Required Under 37 C.F.R. § 1.705(b)(2)

Pursuant to 37 C.F.R. § 1.702, Patentees submit the following statement of facts in support of this application:

- (i) The correct patent term adjustment and the basis or bases under 37 C.F.R. § 1.702 for the adjustment are as follows:

1. Correct patent term adjustment:

The correct patent term adjustment is 1,327 days, which number of days is attributable to (a) the failure of the PTO to mail a notification under 35 U.S.C. § 132 not later than fourteen months after the date on which the '059 application was filed under 35 U.S.C. 111(a) (37 C.F.R. § 1.703(a)(1)) (the "A period"); and (b) the failure of the PTO to issue a patent within three years of the actual filing date of the '059 application (delay under 37 C.F.R. § 1.702(b)) (the "B period"); in which the A period delay listed above excludes periods of delay involving actual calendar days occurring in both the A period and in the "B period," as described below, minus the number of days attributable to the failure of the Patentees to engage in reasonable efforts to conclude prosecution (delay under 37 C.F.R. § 1.704).

2. Bases under 37 C.F.R. § 1.702 for the adjustment:

(a) Delay under 37 C.F.R. § 1.702(a) (the "A period")

The delay by the PTO under 37 C.F.R. § 1.702(a), not counting any days of delay that overlap with periods of delay under 37 C.F.R. § 1.702(b), is 558 days.

As acknowledged by the PTO in its calculation of the patent term adjustment, the PTO failed to mail a notification under 35 U.S.C. § 132 within fourteen months from the date of filing of the '059 application. *See* PTO's Patent Application Information Retrieval page for U.S. Application No. 10/781,059 at Patent Term Adjustment History ("PTO PAIR Adjustment," Exhibit A). The '059 application was filed under 35 U.S.C. § 111(a) on February 17, 2004. The first notification under 35 U.S.C. § 132 (a Restriction Requirement) was mailed by the PTO on October 27, 2006. Accordingly, the PTO did not mail a notification under 35 U.S.C. § 132 or a notice of allowance under 35 U.S.C. § 151 within fourteen months after the date on which the application was filed (or by April 17, 2005), and thus, the PTO delay under 37 C.F.R. § 1.702(a)(1) is 558 days, which is the number of days from April 17, 2005 to October 27, 2006. Patentees note that the 558 days of delay under 37 C.F.R. § 1.702(a)(1) do not overlap with the 1,200 days of delay under 37 C.F.R. § 1.702(b), discussed below.

There were additional delays by the PTO under 37 C.F.R. § 1.702(a), as described in the two paragraphs below, but these additional delay periods overlap with the period of delay under 37 C.F.R. § 1.702(b), and thus, are not being counted in the calculated delay under 37 C.F.R. § 1.702(a).

In particular, the PTO failed to issue the patent within four months after payment of the Issue Fee in accordance with 37 C.F.R. § 1.702(a)(4). Patentees submitted the issue fee payment on October 9, 2009, in response to the Notice of Allowance and Issue Fee Due mailed July 10, 2009. The '732 Patent issued on June 1, 2010. Accordingly, the PTO did not issue the '732 patent within four months of the date on which the issue fee was paid (or by February 9, 2010), and thus, the PTO delay under 37 C.F.R. § 1.702(a)(4) is 111 days, which is the number of days from February 9, 2010 to June 1, 2010. Patentees note that the PTO delay under 37 C.F.R. § 1.702(a)(4) of 111 days is not reflected by the PTO in its calculation of patent term adjustment (*see* "PTO PAIR Adjustment," Exhibit A). However, Patentees also note that the 111 days of delay under 37 C.F.R. § 1.702(a)(4) overlap with the 1,200 days of delay under 37 C.F.R. § 1.702(b), discussed below, and thus, are not being counted towards any calculated delay under Section 702(a).

Further, Patentees note that the PTO failed to mail a Notice of Allowance within four months after the date of a reply in compliance with 37 C.F.R. § 1.113(c) in accordance with 37 C.F.R. § 1.702(a)(2). On September 25, 2008, Patentees filed a Notice of Appeal and a Request for Pre-Appeal Brief Review, in response to a Office Action made Final dated March 26, 2008. The PTO mailed a Notice of Allowance on July 10, 2009. Accordingly, the PTO did not mail an action under 35 U.S.C. § 132, or a notice of allowance under 35 U.S.C. § 151, whichever occurs first, within four months of the date on which the reply in compliance with 37 C.F.R. § 1.113(c) was filed (or by January 25, 2009), and thus, the PTO delay under 37 C.F.R. § 1.702(a)(2) is 165 days, which is the number of days from January 25, 2009 to July 10, 2009. Patentees note that the PTO delay under 37 C.F.R. § 1.702(a)(2) of 165 days is not reflected by the PTO in its calculation of patent term adjustment (*see* "PTO PAIR Adjustment," Exhibit A), and were not requested in the Application for Patent Term Adjustment Under 37 C.F.R. § 1.705(b) filed October 9, 2009. However, Patentees note that the 165 days of delay under 37 C.F.R. § 1.702(a)(2) overlap with the 1,200 days of delay under 37 C.F.R. § 1.702(b), discussed below, and thus, are not being counted towards any calculated delay under Section 702(a).

Thus, the total PTO delay under 37 C.F.R. § 1.702(a) that does not overlap with any delay under Section 702(b) is 558 days.

(b) Delay under 37 C.F.R. § 1.702(b) (the "B period")

The PTO delay under 37 C.F.R. § 1.702(b) is 1,200 days. In the PTO PAIR Adjustment submitted as Exhibit A hereto, the PTO indicates that the "B period" delay is 912 days. However, Patentees submit that this delay of 912 days is incorrect, and submit that the correct adjustment under 37 C.F.R. § 1.702(b) is 1,200 days.

The '059 application was filed under 35 U.S.C. § 111(a) on February 17, 2004, and issued on June 1, 2010. Accordingly, the PTO did not issue a patent within three years of the date on which the application was filed (in this case, February 17, 2007), and thus, the term of the patent should be adjusted because issuance has been delayed. Patentees submit that the period of delay in the B period is 1,200 days, which is equal to the number of days from February 17, 2007 to June 1, 2010. *See* 37 C.F.R. § 1.702(b).

(c) Overlapping Days in the Delay Periods

According to 35 U.S.C. § 154(b)(2)(A): “To the extent that periods of delay attributable to grounds specified in paragraph (1) *overlap*, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.” *See* 35 U.S.C. § 154(b)(2)(A).

Patentees submit that the 558 days of PTO delay under 37 C.F.R. § 1.702(a)(1), discussed in detail above, do not overlap the 1,200 days of delay during the B period. Thus, the period of PTO delay under 37 C.F.R. § 1.702(a) and 37 C.F.R. § 1.702(b) that is non-overlapping is the sum of the number of days of delay during the A period that does not overlap with the days of delay during the B period (558 days) plus the number of days of delay during the B period (1,200 days), which is equal to 1,758 days. *See Wyeth et al. v. Dudas*, 591 F.3d 1364, 93 U.S.P.Q.2d 1257 (Fed. Cir. 2010).

(ii) The relevant dates as specified in 37 C.F.R. §§ 1.703(a) through (e) for which an adjustment is sought and the adjustment as specified in 37 C.F.R. § 1.703(f) are as follows:

1. Adjustment under 37 C.F.R. §§ 1.703(a) through (e):

An adjustment is sought under 37 C.F.R. § 1.703(a)(1), which provides, in relevant part, that the period of adjustment is “[t]he number of days, if any, in the period beginning on the day after the date that is fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first.” The day after the date that is fourteen months after the filing date is April 18, 2005. The date of mailing of an action under 35 U.S.C. § 132 is October 27, 2006. Patentees seek to include the delay under 37 C.F.R. § 1.703(a)(1) occurring from April 18, 2005 to October 27, 2006 (558 days) that occurred on different calendar days than the delay under 37 C.F.R. § 1.702(b). Patentees note that these 558 days occurred on calendar days that do not overlap the delay under 37 C.F.R. § 1.702(b).

Patentees do not seek to include the delay under 37 C.F.R. § 1.703(a)(6) or the delay under 37 C.F.R. § 1.703(a)(3), since these occurred on calendar days overlapping the delay under 37 C.F.R. § 1.702(b).

Thus, the total PTO delay under 37 C.F.R. § 1.702(a) for which an adjustment is sought is 558 days, as described above.

An adjustment is sought under 37 C.F.R. § 1.703(b), which provides, in relevant part, that “the period of adjustment under 37 C.F.R. § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a)...and ending on the date a patent was issued.”

Patentees submit that this period consists of 1,200 days which is the period beginning day after February 14, 2007 (the date that is three years after the date on which the ‘059 application was filed) and ending on the day that the ‘723 patent issued, *i.e.*, June 1, 2010.

Patentees further submit that of the actual calendar days of delay under 37 C.F.R. § 1.702(a) for which an adjustment is sought, the 558 days described above do not overlap any of the 1,200 actual calendar days of delay under 37 C.F.R. § 1.702(b), as explained above.

Accordingly, Patentees’ believe that the delays attributable to the PTO under 37 C.F.R. § 1.702 total **1,758** days (558 days of period A delay, excluding any delay overlapping the period of B delay, plus 1,200 days of period B delay).

2. Adjustment under 37 C.F.R. § 1.703(f):

As discussed in section (i) above, Patentees believe that the total delay by the PTO under 37 C.F.R. § 1.702(a) and (b), excluding overlapping time periods, is 1,758 days. As discussed in section (iv) below, Patentees believe that the number of days of delay attributable to the Patentees under § 1.704 is 431 days. Patentees believe that the total period of adjustment due under 37 C.F.R. § 1.703(f) is **1,327** days, which is the sum of the periods of delay by the PTO calculated under 37 C.F.R. §§ 1.702(a) through (e) (*i.e.*, 1,758 days), to the extent that such periods are not overlapping, less the sum of the periods calculated under 37 C.F.R. § 1.704 (*i.e.*, 431 days), discussed below. Patentees note that the Decision, attached as Exhibit B hereto, determined that the delay under 37 C.F.R. § 1.704 is 431 days.

(iii) The ‘732 patent is not subject to a terminal disclaimer.

(iv) The circumstances during the prosecution of the '059 application that constitute a failure to engage in reasonable efforts to conclude processing or examination of the '059 application as set forth in 37 C.F.R. § 1.704 are believed to consist of the following:

1. 92 days due to Patentees' filing of a response on November 17, 2004, responding to a Notice to File Missing Parts of Nonprovisional Application from the PTO mailed on May 17, 2004. This response was complete and did not have any omission of any item required by the Patent and Trademark Office that was listed in the Notice to File Missing Parts. Because there was no omission, 37 C.F.R. § 1.704(c)(7) does not apply. Thus, filing on November 17, 2004 "stops the clock" and results in a delay of 92 days, which 92 days is the period from August 18, 2004, which is the day after three months from the mailing date of the Notice to File Missing Parts, to the mailing of the response on November 17, 2004.
2. 74 days due to Patentees' filing of a response on August 25, 2006, responding to a second Notice to Comply With Requirements For Patent Applications Containing Nucleotide Sequences and/or Amino Acid Sequence Disclosures ("second Notice to Comply"). On April 12, 2006, the PTO mailed a first Notice to Comply With Requirements For Patent Applications Containing Nucleotide Sequences and/or Amino Acid Sequence Disclosures ("first Notice to Comply"), to which Patentees filed a response on June 12, 2006. Due to errors in the response filed June 12, 2006, the PTO mailed on June 29, 2006 a second Notice to Comply, to which Patentees filed a response on August 25, 2006, and which response did not have any errors. Patentees believe that in view of the errors in the response filed June 12, 2006, 37 C.F.R. § 1.704(c)(7) applies. In view of 37 C.F.R. § 1.704 (c)(7), the filing of the response on August 25, 2006 results in a delay of 74 days, which 74 days is the period from June 13, 2006 to the mailing of the response on August 25, 2006.
3. 82 days due to Patentees' filing of a response on April 19, 2007, responding to a non-final rejection from the PTO mailed on October 27, 2006. The filing of a response on April 19, 2007 results in a delay of 82 days, which 82 days is the period from January 27, 2007, which

is three months after the mailing date of the rejection, to the mailing of the response on April 19, 2007.

4. 92 days due to Patentees' filing of a response on November 29, 2007, responding to a non-final rejection from the PTO mailed on May 29, 2007. The filing of a response on November 29, 2007 results in a delay of 92 days, which 92 days is the period from August 29, 2007, which is three months after the mailing date of the rejection, to the mailing of the response on November 29, 2007.
5. 91 days due to Patentees' filing of a response on September 25, 2008, responding to a final rejection from the PTO mailed on March 26, 2008. The filing of a response on September 25, 2008 results in a delay of 91 days, which 91 days is the period from June 26, 2008, which is three months after the mailing date of the rejection, to the mailing of the response on September 25, 2008.

Accordingly, Patentees believe that the delays attributable to Patentees under 37 C.F.R. § 1.704 total 431 days (92+74+82+92+91).

Patentees wish to point out that in the Decision (attached as Exhibit B hereto), it was determined on page 4 that the patent term adjustment at the time of mailing of the Notice of Allowance was 157 days, which is believed to be incorrect. Patentees believe this is due to a typographical error in the Decision that indicated that the number of days of Office delay is 588 days, instead of 558 days, as discussed above and as indicated in Exhibit A.

In summary, the total adjustment under 37 C.F.R. §§ 1.702(a) and (b) is believed to be 1,758 days, the total delay attributable to Patentees under 37 C.F.R. § 1.704 is believed to be 431 days, and thus the total period of adjustment due under 37 C.F.R. § 1.703(f) is believed to be 1,327 days. Accordingly, Patentees respectfully request an adjustment of patent term under 37 C.F.R. § 1.703(f) totaling 1,327 days.

In accordance with 37 C.F.R. § 1.705(d), this request for reconsideration of patent term adjustment is being filed within two months of June 1, 2010, the issue date of the '732 patent, and thus, is timely filed.

Respectfully submitted,

Date: July 30, 2010



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EXHIBIT A

10/781,059

METHODS FOR IDENTIFYING MODULATORS OF NOTCH ACTIVATION

07-29-
2010::14:35:33**Patent Term Adjustments**

Patent Term Adjustment (PTA) for Application Number: 10/781,059

Filing or 371(c) Date:	02-17-2004	USPTO Delay (PTO) Delay (days):	-
Issue Date of Patent:	06-01-2010	Three Years:	-
Pre-Issue Petitions (days):	-	Applicant Delay (APPL) Delay (days):	-
Post-Issue Petitions (days):	-	Total PTA (days):	1069
USPTO Adjustment(days):	-	Explanation Of Calculations	

Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
06-01-2010	PTA 36 Months	912	
06-01-2010	Patent Issue Date Used in PTA Calculation		
05-04-2010	Dispatch to FDC	⬆	
04-26-2010	Mail-Record a Petition Decision of Granted for Patent Term Adjustment after Allowance	⬆	
04-26-2010	Record a Petition Decision of Granted for Patent Term Adjustment after Allowance	⬆	
04-26-2010	Record a Petition Decision of Granted for Patent Term Adjustment after Allowance	⬆	
04-24-2010	Adjustment of PTA Calculation by PTO	30	
04-24-2010	Adjustment of PTA Calculation by PTO		
04-24-2010	Adjustment of PTA Calculation by PTO	481	
04-24-2010	Adjustment of PTA Calculation by PTO		
10-19-2009	Application Is Considered Ready for Issue	⬆	
10-09-2009	Issue Fee Payment Verified	⬆	
10-09-2009	Petition Entered	⬆	
10-09-2009	Issue Fee Payment Received	⬆	
07-31-2009	Sequence Forwarded to Pubs on Tape	⬆	
07-08-2009	Document Verification	⬆	
07-08-2009	Notice of Allowance Data Verification Completed	⬆	
11-06-2008	Mail Miscellaneous Communication to Applicant	⬆	
11-05-2008	Miscellaneous Communication to Applicant - No Action Count	⬆	
11-03-2008	Date Forwarded to Examiner	⬆	
11-03-2008	Mail Appeals conf. Rej. withdrawn	⬆	
10-31-2008	Pre-Appeals Conference Decision - Rejection Withdrawn	⬆	
09-25-2008	Request for Pre-Appeal Conference Filed	⬆	
09-25-2008	Notice of Appeal Filed	⬆	
10-27-2008	Mail Miscellaneous Communication to Applicant	⬆	
10-26-2008	Miscellaneous Communication to Applicant - No Action Count	⬆	
10-26-2008	Interference Initial Memo Disposal	⬆	
09-25-2008	Miscellaneous Incoming Letter	⬆	
09-25-2008	Request for Extension of Time - Granted	⬆	
03-26-2008	Mail Final Rejection (PTOL - 326)	⬆	
03-17-2008	Final Rejection	⬆	
11-29-2007	Information Disclosure Statement considered	⬆	

01-17-2008	Date Forwarded to Examiner	⬆	
11-29-2007	Response after Non-Final Action		92
11-29-2007	Request for Extension of Time - Granted	⬆	
11-29-2007	Information Disclosure Statement (IDS) Filed	⬆	
11-29-2007	Information Disclosure Statement (IDS) Filed	⬆	
05-29-2007	Mail Non-Final Rejection	⬆	
05-29-2007	Non-Final Rejection		
11-17-2004	Information Disclosure Statement considered		
05-04-2007	Date Forwarded to Examiner		
04-19-2007	Response to Election / Restriction Filed		82
04-19-2007	Request for Extension of Time - Granted	⬆	
01-04-2007	PG-Pub Issue Notification	⬆	
10-27-2006	Mail Restriction Requirement	558	
10-26-2006	Requirement for Restriction / Election	⬆	
11-17-2005	Preliminary Amendment	⬆	
02-17-2006	Preliminary Amendment	⬆	
10-17-2006	Case Docketed to Examiner in GAU	⬆	
10-03-2006	IFW TSS Processing by Tech Center Complete	⬆	
11-17-2004	Reference capture on IDS	⬆	
11-17-2004	Information Disclosure Statement (IDS) Filed	⬆	
11-17-2004	Information Disclosure Statement (IDS) Filed	⬆	
11-17-2004	Preliminary Amendment	⬆	
09-28-2006	Application Dispatched from OIPE	⬆	
09-29-2006	Application Is Now Complete	⬆	
08-25-2006	Additional Application Filing Fees		738
09-28-2006	Change in Power of Attorney (May Include Associate POA)	⬆	
08-25-2006	CRF Disk Has Been Received by Preexam / Group / PCT	⬆	
09-05-2006	CRF Is Good Technically / Entered into Database	⬆	
06-29-2006	SEQUENCE ERRORS	⬆	
06-12-2006	Additional Application Filing Fees	⬆	
06-12-2006	CRF Disk Has Been Received by Preexam / Group / PCT	⬆	
06-21-2006	CRF Is Flawed Technically / Not Entered into Database	⬆	
04-12-2006	SEQUENCE ERRORS	⬆	
11-17-2004	Payment of additional filing fee/Preexam	⬆	
02-17-2004	Claim Preliminary Amendment	⬆	
11-17-2004	A set of symbols and procedures, provided to the PTO on a set of computer listings, that describe in	⬆	
11-17-2004	Applicant has submitted new drawings to correct Corrected Papers problems	⬆	
05-17-2004	Notice Mailed--Application Incomplete--Filing Date Assigned	⬆	
03-31-2004	Cleared by L&R (LARS)		
03-23-2004	Referred to Level 2 (LARS) by OIPE CSR		
03-05-2004	IFW Scan & PACR Auto Security Review		
02-17-2004	Initial Exam Team nn		

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EXHIBIT B



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APR 26 2010

OFFICE OF PETITIONS

In re Application of	:	
Artavanis-Tsakonas et al.	:	DECISION ON APPLICATION
Application No. 10/781,059	:	FOR PATENT TERM ADJUSTMENT
Filed: February 17, 2004	:	
Attorney Docket No. 7326-132 ✓	:	

This is in response to the "Application for Patent Term Adjustment Under 37 C.F.R. § 1.705(b)" filed October 9, 2009. Applicants request the initial determination of patent term adjustment be corrected from zero (0) days to at least one thousand three hundred seventy-six (1,376) days.

The request for reconsideration of the initial determination of patent term adjustment is **granted to the extent indicated herein**.

The Office has updated the PALM screen to reflect the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is 157 days. A copy of the updated PALM screen, showing the corrected determination, is enclosed.

The Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) in the above-identified application on July 10, 2009. Applicants were advised of a patent term adjustment to date of 0 days. In response, applicants timely filed this application for patent term adjustment with payment of the issue fee on October 9, 2009.

Delay Under 37 C.F.R. § 1.703(b)

To the extent applicants request reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the request is premature.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See 37 C.F.R. § 1.702(b). (This is true even where a request for continued examination was filed). The computer will not undertake the 37 C.F.R. § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under 37 C.F.R. § 1.702(a)(4) or applicant delay under 37 C.F.R. § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 C.F.R. § 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature.

Rather than file an application for patent term adjustment under 37 C.F.R. § 1.705(b) contesting the 37 C.F.R. § 1.702(b) calculation at the time of the mailing of the notice of allowance, an applicant may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 C.F.R. § 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 C.F.R. § 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 C.F.R. § 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee.¹

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 C.F.R. § 1.705(d) and must include payment of the required fee under 37 C.F.R. § 1.18(e). ✓

Applicant Delay Under 37 C.F.R. § 1.704 Involving Conduct Between
May 17, 2004, and August 25, 2006

Applicants dispute the propriety of the Office's entry of a 738-day reduction for alleged delay in responding to the Notice to File Missing Parts of Nonprovisional Application mailed May 17, 2004.

The period of 738 days is the number of days beginning May 17, 2004, the day after the date three months after the Office mailed the Notice to File Missing Parts, and ending on August 25, 2006, the date a reply to a Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures ("Notice to Comply") was filed.

Background Facts

The Office mailed a Notice to File Missing Parts of Nonprovisional Application on May 17, 2004.

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 C.F.R. § 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 C.F.R. § 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 C.F.R. § 1.705(b) and 35 U.S.C. § 154(b)(3)(B). A dispute as to the calculation of the § 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 C.F.R. § 1.705(d) will be dismissed as untimely filed.

A proper reply to the Notice to File Missing Parts was filed November 17, 2004.

A Notice to Comply was mailed April 12, 2006.

A reply to the April 12, 2006 Notice to Comply was filed June 12, 2006.

A second Notice to Comply was mailed June 29, 2006.

A reply to the June 29, 2006 Notice to Comply was filed August 25, 2006.

Discussion

Applicants assert entry of the 738-day reduction was improper.

Applicants assert the Office should have entered:

- (1) A 92-day reduction for delay in responding to the Notice to File Missing Parts,
- (2) A 74-day reduction for the filing of a reply with an omission on June 12, 2006.

A reply to the Notice to File Missing Parts was filed three months and 92 days after the Office mailed the Notice. Therefore, the Office should have entered a reduction of 92 days, not 738 days, under 37 C.F.R. § 1.704(b).

The reply to the First Notice to Comply included an omission requiring the Office to mail the Second Notice to Comply. The number of days beginning on June 13, 2006, the day after the date the reply to the First Notice to Comply was filed, and ending on August 25, 2006, the date the reply to the Second Notice to Comply was filed, is 74 days. Therefore, a 74-day reduction should have been entered under 37 C.F.R. § 1.704(c)(7).

Applicant Delay Involving Delay in Responding to the March 26, 2008 Office action

A review of the record indicates a 91-day reduction should have been entered as a result of delay in responding to the March 26, 2008 Office action.

The Office mailed an Office action on March 26, 2008. A reply was not filed until three months and 91 days later on September 25, 2008. Therefore, a 91-day reduction should have been entered under 37 C.F.R. § 1.704(b).

The Office has entered a 91-day reduction for delay in responding to the May 26, 2008 Office action.

Conclusion

As previously discussed, the Office should not have entered a 783-day reduction for delay in responding to the Notice to File Missing Parts. The Office has removed the 783-day reduction.

As previously discussed, the Office should have entered a 92-day reduction for delay in responding to the Notice to File Missing Parts. The Office has entered the 92-day reduction.

As previously discussed, the Office should have entered a 74-day reduction as a result of the filing of a reply with an omission on June 12, 2006. The Office has entered the 74-day reduction.

As previously discussed, the Office should have entered a 91-day reduction as a result of Applicants' delay in responding to the May 26, 2008 Office action. The Office has entered the 91-day reduction.

The total amount of Applicants' delay under 37 C.F.R. § 1.704, as of the date the Notice of Allowance was mailed, is 431 (82 + 92 + 92 + 74 + 91)² days.

The patent term adjustment at the time of the mailing of the Notice of Allowance is 157 days which is 588 days of Office delay under 37 C.F.R. § 1.703(a) reduced by 431 days for Applicant's delay under 37 C.F.R. § 1.704.

Applicants are reminded that any delays by the Office pursuant to 37 C.F.R. §§ 1.702(a)(4) and 1.702(b) and any applicant delays under 37 C.F.R. § 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.



Anthony Knight
Director
Office of Petitions

Enclosure: Copy of REVISED PALM screen

² The 82-day reduction was the result of Applicants' delay in responding to the October 27, 2006 Office action and is not in dispute. The first 92-day reduction is the result of Applicants' delay in responding to the non-final Office action mailed May 29, 2006, and is not in dispute.

Day : Saturday
Date: 4/24/2010

PALM INTRANET

Time: 09:29:17

PTA Calculations for Application: 10/781059					
Application Filing Date:	02/17/2004	PTO Delay (PTO):	558		
Issue Date of Patent:		Three Years:	0		
Pre-Issue Petitions:	0	Applicant Delay (APPL):	912		
Post-Issue Petitions:	0	Total PTA (days):	157		
PTO Delay Adjustment:	511				
File Contents History					
Number	Date	Contents Description	PTO	APPL	START
93	04/24/2010	ADJUSTMENT OF PTA CALCULATION BY PTO	30		
92	04/24/2010	ADJUSTMENT OF PTA CALCULATION BY PTO	481		
83	07/10/2009	MAIL NOTICE OF ALLOWANCE			
82	07/08/2009	ISSUE REVISION COMPLETED			
81	07/08/2009	DOCUMENT VERIFICATION			
80	07/08/2009	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
79	07/06/2009	NOTICE OF ALLOWABILITY			
72	11/06/2008	MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT			
71	11/05/2008	MISCELLANEOUS COMMUNICATION TO APPLICANT - NO ACTION COUNT			
69	11/03/2008	DATE FORWARDED TO EXAMINER			
68	11/03/2008	MAIL APPEALS CONF. REJ. WITHDRAWN			
67	10/31/2008	PRE-APPEALS CONFERENCE DECISION - REJECTION WITHDRAWN			
66	09/25/2008	REQUEST FOR PRE-APPEAL CONFERENCE FILED			
65	09/25/2008	NOTICE OF APPEAL FILED			
64	10/27/2008	MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT			
63	10/26/2008	MISCELLANEOUS COMMUNICATION TO APPLICANT - NO ACTION COUNT			
62	10/26/2008	INTERFERENCE INITIAL MEMO DISPOSAL			
61	09/25/2008	MISCELLANEOUS INCOMING LETTER			
58	09/25/2008	REQUEST FOR EXTENSION OF TIME - GRANTED			
57	03/26/2008	MAIL FINAL REJECTION (PTOL - 326)			

56	03/17/2008	FINAL REJECTION			
55	11/29/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
54	01/17/2008	DATE FORWARDED TO EXAMINER			
53	11/29/2007	RESPONSE AFTER NON-FINAL ACTION		92	49
52	11/29/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
51	11/29/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
50	11/29/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
49	05/29/2007	MAIL NON-FINAL REJECTION			
48	05/29/2007	NON-FINAL REJECTION			
47	11/17/2004	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
46	05/04/2007	DATE FORWARDED TO EXAMINER			
45	04/19/2007	RESPONSE TO ELECTION / RESTRICTION FILED		82	42
44	04/19/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
43	01/04/2007	PG-PUB ISSUE NOTIFICATION			
42	10/27/2006	MAIL RESTRICTION REQUIREMENT	558		-1
41	10/26/2006	REQUIREMENT FOR RESTRICTION / ELECTION			
39	11/17/2005	PRELIMINARY AMENDMENT			
38	02/17/2006	PRELIMINARY AMENDMENT			
37	10/17/2006	CASE DOCKETED TO EXAMINER IN GAU			
36	10/03/2006	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
35	11/17/2004	REFERENCE CAPTURE ON IDS			
34.7	11/17/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
34	11/17/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
33	11/17/2004	PRELIMINARY AMENDMENT			
32	09/28/2006	APPLICATION DISPATCHED FROM OIPE			
31	09/29/2006	APPLICATION IS NOW COMPLETE			
30	08/25/2006	ADDITIONAL APPLICATION FILING FEES		738	8
29	09/28/2006	CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA)			
28	08/25/2006	CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT			

27	09/05/2006	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
26	06/29/2006	SEQUENCE ERRORS			
23	06/12/2006	ADDITIONAL APPLICATION FILING FEES			
22	06/12/2006	CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT			
21	06/21/2006	CRF IS FLAWED TECHNICALLY / NOT ENTERED INTO DATABASE			
20	04/12/2006	SEQUENCE ERRORS			
19	11/17/2004	PAYMENT OF ADDITIONAL FILING FEE/PREEXAM			
18	02/17/2004	CLAIM PRELIMINARY AMENDMENT			
16	11/17/2004	A SET OF SYMBOLS AND PROCEDURES, PROVIDED TO THE PTO ON A SET OF COMPUTER LISTINGS, THAT DESCRIBE IN			
15	11/17/2004	APPLICANT HAS SUBMITTED NEW DRAWINGS TO CORRECT CORRECTED PAPERS PROBLEMS			
8	05/17/2004	NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED			
5	03/31/2004	CLEARED BY L&R (LARS)			
4	03/23/2004	REFERRED TO LEVEL 2 (LARS) BY OIPE CSR			
3	03/23/2004	CASE CLASSIFIED BY OIPE			
2	03/05/2004	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	02/17/2004	INITIAL EXAM TEAM NN			

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EXPLANATION OF PTA CALCULATION

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